



PATENT

Attorney Docket No. UM-03662

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Marc Peters-Golden *et al.*

Serial No.: 09/291,656

Art Unit: 1653

Filed: 03/03/1999

Examiner: Carlson

Entitled: Administration Of Products Of The 5-Lipoxygenase Metabolic Pathway
To Enhance Antimicrobial Defense

REPLY BRIEF TO EXAMINER'S
ANSWER TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)(1)(i)(A)

I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is, on the date shown below, being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: November 14, 2006

By:

Traci E. Light

Sir or Madam:

Transmitted herewith is a Reply Brief (37 CFR 1.193) to Examiner's Answer, mailed September 15, 2006.

The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 08-1290. **An originally executed duplicate of this transmittal is enclosed for this purpose.**

Dated: November 14, 2006

By:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Marc Peters-Golden *et al.*
Serial No.: 09/291,656 Art Unit.1653
Filed: 03/03/199 Examiner: Carlson
Entitled: **Administration Of Products Of The 5-Lipoxygenase Metabolic
Pathway To Enhance Antimicrobial Defense**

**REPLY BRIEF (37 CFR § 1.193) TO EXAMINER'S
ANSWER MAILED SEPTEMBER 15, 2006**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Dated: 11/14/2006

By: 

Traci E. Light

Examiner Carlson:

Please enter the following Reply Brief on the record in answer to the Examiner's Answer mailed September 15, 2006 wherein new arguments were made. See pp 5-6 of the Examiner's Answer. Pursuant to 37 CFR § 1.193, the Applicants hereby provide a rebuttal to these new arguments.

Since the Reply Brief is filed within two months of the date of mailing of the Answer, the Reply Brief is timely. Nonetheless, if there are any fees required and/or any required Petition for Extension of Time for filing this Reply Brief, they are dealt with in the accompanying **TRANSMITTAL OF REPLY BRIEF**.

ARGUMENT

The Examiner raises several new points of argument and reasserts old arguments. The Applicants provide argument below in rebuttal to the Examiner's new arguments. Moreover, this Reply Brief serves to clarify the Applicants' position on the Examiner's old arguments. In regards to other statements within the Examiner's Answer, not explicitly referred to herein, the Applicant's Appeal Brief is herein incorporated by reference.

I. Gosselin et al. Does Not Disclose A Leukotriene Aerosol

The Examiner maintains that "an aerosol" is disclosed before the Applicants' filing date by reasserting only the Gosselin et al. patent¹ at col 11 line 32. *Examiner's Answer pg 5*. This is of no moment, because that Examiner cannot show that the Gosselin et al. parent application ('059 application) also discloses aerosols. Since Applicants filed the present case prior to the date of the continuation-in-part (now the '441 patent), the Applicants disclosed aerosols comprising leukotrienes before Gosselin et al.

II. 'An Aerosol' Is A Composition Of Matter

The Examiner inappropriately attempts to equate 'an aerosol' and 'a solution' by stating that "... each droplet within an aerosol is the sterile solution ...". *Examiner's Answer pg 5*. The Applicants disagree and point out that an art-accepted definition of 'an aerosol' identifies a composition of matter (i.e., aerosol is defined as a noun), for example:

- aer·o·sol (âr-sôl) n. 1. A gaseous suspension of fine solid or liquid particles.
- 2. A substance, such as a drug containing therapeutically active ingredients, packaged under pressure with a gaseous propellant for release as a spray of fine particles.

¹ The Gosselin et al. patent does not pre-date the Applicants' priority date (see Applicants' Appeal Brief).

The American Heritage® Stedman's Medical Dictionary, Copyright © 2002, 2001, 1995 by Houghton Mifflin Company. Published by Houghton Mifflin Company. Clearly, an aerosol is a composition of matter within its own right.

III. “Wherein Said Solution Is An Aerosol” Is Not Intended Use Language

The Examiner uses great imagination by stating that “The instant claims phrase “wherein said solution is an aerosol” is also a form of the solution in a particular form for an intended use” by continued mis-reliance on *Union Oil. Examiner’s Answer pg 5*. The Applicants find this conclusion contrary to well accepted claim construction interpretation. If the Examiner’s statement were true (which it is not) the following claims phrase would also encompass intended use; “wherein said mammal is a cow”. Embodiments that clarify ‘the general to the specific’ are common and well accepted in patent law. The Applicants’ argue that the Examiner is resorting to personal opinion without providing evidence or affidavit.

IV. *Rosicky & Lerner* Are Not Applicable

The Examiner attempts to rebut the Applicants’ arguments against relying on *Rosicky and Lerner* for demonstrating that “an aerosol” has no patentable weight. The Examiner concludes by stating that: “... the advantages of pharmaceutical compositions of leukotrienes are taught in Gosselin et al.”. *Examiner’s Answer pg 5*. This is of no moment because whether Gosselin et al. discloses any advantages is not relevant². Further, during prosecution, the Examiner asserted *Rosicky and Lerner* directly against the Applicants’ presently claimed embodiment. As discussed in the Appeal Brief, the holdings of *Rosicky and Lerner* are not applicable to the facts of the presently claimed embodiment because the Applicants’ specification discusses many advantages of aerosols.

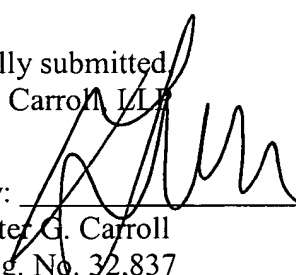
² The Examiner is reminded that Gosselin et al. is not prior art regarding an aerosol.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that Applicants' Claims 22-25 and 27-37 should be passed to allowance. Appellants ask that the Board reverse the Examiner and send the case on for disposition consistent with the above.

Respectfully submitted,
Medlen & Carroll, LLP

Dated: November 14, 2006

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